



Application No. (if known): 10/084,831

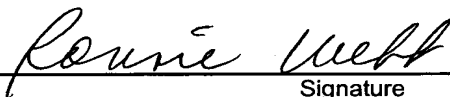
Attorney Docket No.: HO-P02917US5

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MS Non-Fee Amendment
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on March 3, 2005
Date


Signature

Ronnie Webb

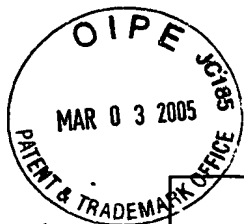
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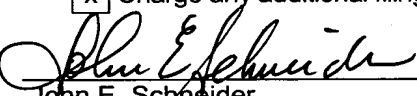
Registration Number, if applicable

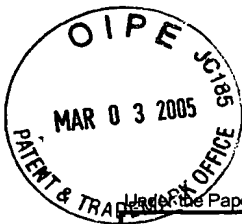
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One Month Request for Extension of Time Under 37 CFR 1.136(a) (1 page)
Amendment in Response to Non-Final Office Action (12 pages)
Amendment Transmittal (1 page)
Transmittal (1 page)
Charge \$60.00 to deposit account 06-2375
Return Receipt Postcard
Copy of Office Action dated 11/4/2004



| AMENDMENT TRANSMITTAL LETTER | | | | Docket No. HO-P02917US5 | |
|--|---|---|-----------------------------------|-----------------------------|-------|
| Application No. 10/084,831 | | Filing Date February 26, 2002 | | Examiner C. D. Toomer | |
| | | | | Art Unit 1714 | |
| Applicant(s): Frederick L. Jordan | | | | | |
| Invention: METHOD AND COMPOSITION FOR USING ORGANIC, PLANT-DERIVED, OIL-EXTRACTED MATERIALS IN COAL-BASED FUELS FOR REDUCED EMISSIONS | | | | | |
| TO THE COMMISSIONER FOR PATENTS | | | | | |
| Transmitted herewith is an amendment in the above-identified application. | | | | | |
| The fee has been calculated and is transmitted as shown below. | | | | | |
| CLAIMS AS AMENDED | | | | | |
| | Claims Remaining After Amendment | Highest Number Previously Paid | Number Extra Claims Present | Rate | |
| Total Claims | 40 | - 92 = | | x | |
| Independent Claims | 4 | - 8 = | | x | |
| Multiple Dependent Claims (check if applicable) <input type="checkbox"/> | | | | | |
| Other fee (please specify): Extension for response within first month | | | | | 60.00 |
| TOTAL ADDITIONAL FEE FOR THIS AMENDMENT: | | | | | 60.00 |
| <input type="checkbox"/> Large Entity <input checked="" type="checkbox"/> Small Entity | | | | | |
| <input type="checkbox"/> No additional fee is required for this amendment. | | | | | |
| <input checked="" type="checkbox"/> Please charge Deposit Account No. <u>06-2375</u> in the amount of \$ <u>60.00</u> . A duplicate copy of this sheet is enclosed. | | | | | |
| <input type="checkbox"/> A check in the amount of \$ _____ to cover the filing fee is enclosed. | | | | | |
| <input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached. | | | | | |
| <input checked="" type="checkbox"/> The Director is hereby authorized to charge and credit Deposit Account No. <u>06-2375</u> as described below. A duplicate copy of this sheet is enclosed. | | | | | |
| <input checked="" type="checkbox"/> Credit any overpayment. | | | | | |
| <input checked="" type="checkbox"/> Charge any additional filing or application processing fees required under 37 CFR 1.16 and 1.17. | | | | | |
|  John E. Schneider Attorney Reg. No.: 31,998 FULBRIGHT & JAWORSKI L.L.P. 1301 McKinney, Suite 5100 Houston, Texas 77010-3095 (713) 651-5462 | | | | Dated: <u>March 3, 2005</u> | |



PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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| | | | |
|---|--|------------------------|---------------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | | Application Number | 10/084,831 |
| | | Filing Date | February 26, 2002 |
| | | First Named Inventor | Frederick L. Jordan |
| | | Art Unit | 1714 |
| | | Examiner Name | C. D. Toomer |
| Total Number of Pages in This Submission | | Attorney Docket Number | HO-P02917US5 |

ENCLOSURES (Check all that apply)

| | | |
|---|---|--|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard Copy of Office Action dated November 4, 2004 Certificate of Mailing |
| <div>Remarks</div> | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|-----------------------------|----------|--------|
| Firm Name | FULBRIGHT & JAWORSKI L.L.P. | | |
| Signature | | | |
| Printed name | John E. Schneider | | |
| Date | March 3, 2005 | Reg. No. | 31,998 |



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|---------------------------------|------------|----------------------|---------------------|------------------|
| APPLICATION NO. | INVENTOR | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/084,831 | 02/26/2002 | Frederick L. Jordan | HO-P02917USS | 4094 |
| 20995 | 7590 | 11/04/2004 | EXAMINER | |
| KNOBBE MARTENS OLSON & BEAR LLP | | | TOOMER, CEPHIA D | |
| 2040 MAIN STREET | | | ART UNIT | |
| FOURTEENTH FLOOR | | | PAPER NUMBER | |
| IRVINE, CA 92614 | | | 1714 | |

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

10/084,831

Applicant(s)

JORDAN, FREDERICK L.

Examiner

Cephia D. Toomer

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-64,66-74 and 76-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 57-64,66-74 and 76-91 is/are allowed.
- 6) ☐ Claim(s) 39-42,47-50,53 and 54 is/are rejected.
- 7) ☒ Claim(s) 43-46,51,52,55 and 56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 12, 2004 has been entered.
2. This Office action is in response to the amendment filed August 12, 2004 in which claims 46, 48, 52, 57, 63, 66, 76, 80, 84 and 90 were amended and claims 65, 75 and 92 were canceled.
3. The rejections of the claims under 35 USC 112, first and second paragraphs are withdrawn in view of the amendment to the claims and Applicant's arguments.
4. The rejection of the claims under 35 USC 102(b) is withdrawn in view of the amendment to the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 39-42, 47-50 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk (US 5,023,095).

Kirk teaches a composition comprising beta-carotene, at least one edible oil and dl-alpha-tocopherol (see abstract; col. 2, lines 17-24). The edible oil may be selected from coconut, palm, olive, peanut (a member of the *Leguminosae* family), and corn (grain). Kirk teaches that the oils may be used in combination (see col. 3, lines 22-28). Kirk also teaches that dl-alpha-tocopherol is an antioxidant (see col. 3, lines 47-50). Kirk teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Kirk differs from the claims in that she does not specifically teach applicant's intended use. However, intended use is given no patentable weight in claims that are directed to the composition per se.

In the second aspect, Kirk differs from the claims in that she does not teach that the edible oils function as thermal stabilizers. However, given that Kirk teaches some of the same oils as applicant in combination with beta-carotene, it would be reasonable to expect that the oils would function in this capacity. Furthermore, a compound and its properties are inseparable. In re Papesch, 137 USPQ 43 (CCPA 1963).

7. Claims 43-46, 51, 52, 55 and 56 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


8. Claims 57-64, 66-74 and 76-91 are allowed. The prior art fails to teach or suggest the claimed fuel additive and fuel compositions containing said additive.

Art Unit: 1714

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cephia D. Toomer
Primary Examiner
Art Unit 1714

10084831\103004

| | | | |
|-----------------------------------|---------------------------------------|--|-------------|
| Notice of References Cited | Application/Control No. 10/084,831 | Applicant(s)/Patent Under Reexamination JORDAN, FREDERICK L. | |
| | Examiner Cephia D. Toomer | Art Unit 1714 | Page 1 of 1 |

U.S. PATENT DOCUMENTS

| * | | Document Number Country Code-Number-Kind Code | Date MM-YYYY | Name | Classification |
|---|---|--|-----------------|----------------|----------------|
| | A | US-5,023,095 | 06-1991 | Kirk, Paula S. | 426/250 |
| | B | US- | | | |
| | C | US- | | | |
| | D | US- | | | |
| | E | US- | | | |
| | F | US- | | | |
| | G | US- | | | |
| | H | US- | | | |
| | I | US- | | | |
| | J | US- | | | |
| | K | US- | | | |
| | L | US- | | | |
| | M | US- | | | |

FOREIGN PATENT DOCUMENTS

| * | | Document Number Country Code-Number-Kind Code | Date MM-YYYY | Country | Name | Classification |
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NON-PATENT DOCUMENTS

| * | | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
|---|---|---|
| | U | |
| | V | |
| | W | |
| | X | |

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.